

### REMARKS

The present application was filed on September 1, 2000 with claims 1-48. Claims 1, 33, 37 and 46 are the independent claims.

In the present Office Action, claims 1-48 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,157,644 to Bernstein et al. (hereinafter "Bernstein"). Applicants continue to traverse the §102(e) rejection, and respectfully request reconsideration of the present application in light of the following remarks.

Applicants initially note that, in the Office Action, the Examiner neglects to address the particular limitations of claims 16, 19-36 (including independent claim 33) and 38-45. 37 C.F.R. §1.104(c)(2) requires:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (*emphasis added*)

Furthermore, the Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §7.06.02(i) states that, when making a rejection, "the particular part of a reference relied upon to support the rejection should be identified." Applicants respectfully submit that, under these requirements, the §102(e) rejection of claims 16, 19-36 and 38-45 is clearly deficient. These deficiencies make the Examiner's broad assertion that Bernstein anticipates each and every one of the 48 pending claims in the present application untenable. Any subsequent Office Action addressing these deficiencies should be made non-final in order to give Applicants an opportunity to consider an appropriate rejection of claims 16, 19-36 and 38-45.

Applicants also note that MPEP §2131 specifies that a given claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,

631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the “identical invention . . . in as complete detail as is contained in the . . . claim,” citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Independent claim 1 is directed to a method of accelerating the routing of frames by an acceleration switch within a network. The method includes the steps of receiving, by the acceleration switch, frames directed to one of one or more routers or switches of the network; determining, for at least some of the received frames, whether the frames belong to a first list of frame groups, defined by values of a plurality of frame parameters; and routing, by the acceleration switch, at least some of the received frames, the routed frames being selected responsive to the determining.

In formulating the rejection of claim 1, the Examiner relies on the teachings of Bernstein in the flow diagram of FIG. 9 and in the corresponding text in column 6, lines 15-25, and column 7, lines 4-22. The relied-upon text from Bernstein provides as follows:

Referring to the flow chart of FIG. 9, the router accelerator switch of the present invention operates as follows. The switch waits for a packet to arrive either at a network-side port or a router-side port (step 900). When a packet is received over one of the network ports (step 902) as being directed to the router as a next hop, it is intercepted by the router accelerator switch at the switch’s associated network port input. The PPL 604 then extracts the IP destination address from the packet frame (step 904) and forwards it to the port’s packet-forwarding table for comparison with the IP destination addresses stored in the CAM of the PFT (steps 906, 908). The packet processing logic 604 also instructs the memory controller to store the packet in the shared memory packet storage.

...

At this point, the packet forwarding table now stores the address binding for a first packet in a stream of packets directed towards a particular destination, where the packet has been processed by the router. If the next received packet is from the network, then the network-side packet processing logic 604 for the input port causes the memory controller 620

to store the packet in shared memory 612 and to extract the destination address from the IP datagram header (steps 900, 902, 904). The packet processing logic then causes the IP destination address to be input to the associated packet forwarding table (step 906). If the table indicates a hit, then the table transfers the associated physical (layer 2) next hop address to the packet processing logic (steps 908, 910). The packet processing logic causes the memory controller to forward the IP datagram to the packet processing logic 604, which encapsulates the datagram in a frame including the layer 2 next hop address (step 912). The packet processing logic 604 then forwards the frame to the next hop destination on the appropriate output port (step 914).

Applicants respectfully submit that the relied-upon portions of Bernstein disclose nothing more than conventional router acceleration of the type described in the background section of their specification, for example, at page 1, lines 21-31. For example, Bernstein's accelerator relies solely upon the IP destination address in order to identify upon which frames to act. As a result, there is no teaching or suggestion in the relied-upon portions, or the associated flow diagram of FIG. 9, regarding the claimed determining, for at least some of the received frames, whether the frames belong to a first list of frame groups, defined by values of a plurality of frame parameters, and routing, by the acceleration switch, at least some of the received frames, the routed frames being selected responsive to the determining. Since Bernstein fails to meet at least one limitation of independent claim 1, that claim is not anticipated by Bernstein.

Independent claim 37 contains a similar limitation to that found in claim 1. That is, claim 37 describes an acceleration switch wherein frames are defined "by a plurality of parameters of the frames." As a result, Applicants respectfully assert that claim 37 is allowable for reasons similar to those stated above with respect to claim 1.

Dependent claims 2-32 and 38-45 are believed allowable for at least the reasons identified above with regard to independent claims 1 and 37. In addition, Applicants submit that these claims contain separately patentable subject matter over Bernstein and other references of record. For example, dependent claim 8 sets forth "[a] method according to claim 1, wherein determining, for

at least some of the received frames comprises determining for frames which may require access control.” In formulating the §102(e) rejection of this claim, the Examiner argues that these dependent claims are anticipated by “the MAC frames and datagram packets” of Bernstein’s FIGS. 2 and 4 (Office Action, p. 3). Applicants respectfully disagree. Bernstein does not describe or suggest any form of access control. In fact, the words “MAC” and “access” are not found anywhere in the Bernstein reference, either in the figures or in the text.

Moreover, claims 20-32 describe a method according to claim 1 further comprising “determining, for at least some of the received frames, whether the frames belong to a group in at least one additional list of frame groups” (*emphasis added*). Bernstein does not describe such additional lists. What is more, as mentioned earlier, the Examiner fails to address claims 20-32 with particularity anywhere in the Office Action.

Finally, Applicants note that claims 39 and 40 reference a “MAC address.” Claim 44 refers to a “VLAN” (Virtual Local Area Network).” Bernstein, in its entirety, does not refer to either one of these elements. Applicants respectfully assert that anticipation rejection in such a case cannot be supported.

With regard to independent claim 46, Applicants note that claim 46 is directed to a method for creating an acceleration routing table. This method includes the steps of receiving frames which include routing data; determining, responsive substantially only to information within the received frames, whether frames routed based on the routing data of the received frames may violate policy rule; and creating entries in an acceleration routing table based on routing data which may not cause violation of policy rules according to the determination, wherein entries are not created based on routing data which may cause violation of policy rules according to the determination.

In formulating the §102(e) rejection of this claim, the Examiner states:

Regarding claims 46-48, the limitation regarding “the violation of policy rules” reads on the situation shown in the decision blocks of 908 and/or 916 of Fig. 9, in which decisions are made depending on whether the destination is found in the table, and whether the packet

is from the switch. The criteria of violation of policy rules can read on the situation that the destination is (or is not) found in the table. See Fig. 9.

Applicants respectfully disagree. Policy rules generally relate to access control (e.g., who can access specific systems, what they can do within them, and when they are allowed access.) In various embodiments of the present invention, for example, policy rules pertain to groups of frames which should not be routed by the accelerator switch. See, for instance, the specification, p. 18, lines 27-29. Bernstein does not describe or suggest such access control or policy rules. As a result, it cannot be assumed, as the Examiner appears to argue, that the presence or absence of destination addresses in Bernstein's packet forwarding table is in any way indicative of a violation of policy rules.

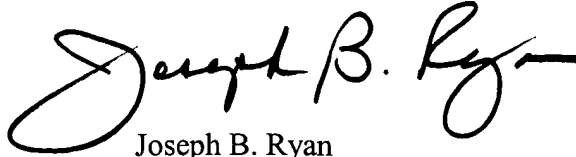
Moreover, claim 46 is directed to a method for creating an acceleration routing table comprising the steps of creating entries or not creating entries in an acceleration routing table according to a determination with respect to policy rules. The Examiner fails to address these claim limitations in the Office Action. Applicants, therefore, respectfully suggest that the §102(e) rejection of this claim is also improper under 37 C.F.R. §1.104(c)(2) and MPEP§7.06.02(i) (quoted above).

Dependent claims 47 and 48 are believed allowable for at least the reasons identified above with regard to independent claim 46.

In view of the above, Applicants believe that claims 1-48 are in condition for allowance.

As indicated previously, a Notice of Appeal is submitted concurrently with this response.

Respectfully submitted,

A handwritten signature in black ink, reading "Joseph B. Ryan". The signature is fluid and cursive, with a large initial "J" and a long horizontal stroke at the end.

Date: January 19, 2005

Joseph B. Ryan  
Attorney for Applicant(s)  
Reg. No. 37,922  
Ryan, Mason & Lewis, LLP  
90 Forest Avenue  
Locust Valley, NY 11560  
(516) 759-7517

Enclosure(s): Notice of Appeal